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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,777	03/28/2006	William F. Rossiter	0579-1121	5523
466 7590 02/09/2010 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			EXAMINER ANDLER, MICHAEL S	
			ART UNIT 2876	PAPER NUMBER
			NOTIFICATION DATE 02/09/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

**Office Action Summary****Application No.**

10/573,777

**Applicant(s)**

ROSSITER, WILLIAM F.

**Examiner**

Michael Andler

**Art Unit**

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The examiner acknowledges and has entered the amendments/arguments filed on 22 December 2009. Claims **1, 3-8, 10, 12-15, 18 and 20-28** are currently pending.

#### ***Claim Objections***

2. The objection to claim **1** is withdrawn in light of the amendment filed on 22 December 2009.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claims **1, 3-8, 10, 12-15, 18 and 20-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Anders et al. (US 7,384,000) in view of Nishikawa et al. (US 5,581,065).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Regarding claims **1, 21-23, 25 and 28**, Anders et al. discloses a card, comprising:

a card body (Fig 1),

a token precut in the card body and extending up to only a single corner of the card body (Fig 1, item 10), and

an L-shaped remainder portion of the card body removably joined to the token (Fig 1, item 12),

the token carrying visual information (Fig 1, item 20) and including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring (Fig 1, item 15).

Anders et al. suggests that "the frame might be further divided by additional recesses (not shown), to provide an ID tag or the like" (Col 3, lines 50-52).

Anders et al. does not specifically teach a microcircuit card precut in the card body adjacent to the token in the remainder portion and removably joined to the token and the remainder portion wherein the microcircuit card conforms to ID-000 format and wherein the visual information includes an address or a phone number.

Nishikawa et al. discloses a microcircuit card precut in the card body adjacent to the token in the remainder portion and removably joined to the token and the remainder portion (Figs 8a) and wherein the visual information includes an address or a phone number (Fig 47B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine a miniature phone card and a SIM card onto the same card carrier in order to provide both products to a consumer in a single package rather than in two separate packages.

Regarding claim 3, Anders et al. discloses wherein the token extends to only one corner of the card body (Fig 1).

Regarding claim 4, Anders et al. discloses wherein the token extends to a corner having a furthest distance from the microcircuit card (Fig 1).

Regarding claim 5, Anders et al. discloses wherein the token has sides at least approximately parallel to those of the card body (See Fig 1 and Col 3, lines 25-38 where the mini card and standard card are both rectangular in shape).

Regarding claim 6, Anders et al. discloses wherein the token has sides at least approximately aligned with the sides of the microcircuit card (See Fig 1 and Col 3, lines 25-38 where the mini card and standard card are both rectangular in shape).

Regarding claim 7, Anders et al. discloses wherein the card body conforms to ID-1 format (See Fig 1 dimensions).

Regarding claim 8, Anders et al. as modified by Nishikawa et al. as applied to claim 1 above, discloses all the limitations of claim 1.

Anders et al. suggests that "the frame might be further divided by additional recesses (not shown), to provide an ID tag or the like" (Col 3, lines 50-52).

Anders et al. does not specifically teach wherein the microcircuit card conforms to ID-000 format.

Nishikawa et al. discloses wherein the microcircuit card conforms to ID-000 format (Fig 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine a miniature phone card and a SIM card onto the same

card carrier in order to provide both products to a consumer in a single package rather than in two separate packages.

Regarding claims **10, 18 and 20**, Anders et al. discloses wherein the token includes a magnetic strip configured to store information (Fig 1, item 17).

Regarding claim **12**, Anders et al. discloses wherein the hole is in a corner of the token in a vicinity of the microcircuit card (See Fig 1, item 15 where all the corners of the mini card can be considered to be in the vicinity of the frame).

Regarding claim **13**, Anders et al. discloses wherein the token is connected to the remainder portion of the card body by mechanically weakened areas consisting of grooves (See Fig 1, item 14 and Col 5, lines 9-12).

Regarding claims **14-15**, Anders et al. discloses wherein the token is a contactless type radio-frequency identification label (Col 4, lines 1-5).

Regarding claim **24**, Anders et al. discloses wherein the visual information includes personalizing information (Col 5, lines 43-45).

Regarding claim **26**, Anders et al. discloses wherein the visual information is provided in ink (Col 5, lines 40-45).

Regarding claim **27**, Anders et al. discloses wherein the visual information comprises characters in relief (See Fig 1, item 20 and Col 5, lines 43-45 where it is understood that account numbers are normally printed on a credit card by embossing).

#### ***Response to Arguments***

4. Regarding claims **1 and 21-23**, applicant has amended the claims to add the limitation of "a remainder portion of the card body removably joined to both the

microcircuit card and the token" and has argued that the previously cited prior art references do not teach this additional limitation.

Applicant's arguments with respect to claims **1 and 21-23** and their respective dependent claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Andler whose telephone number is (571) 270-5385 and whose e-mail address is michael.andler@uspto.gov. The examiner can normally be reached on Monday-Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2876

/Michael Andler/

Examiner, Art Unit 2876

/Michael G Lee/

Supervisory Patent Examiner, Art Unit 2876